

REMARKS

I. Introduction

In response to the Office Action, Applicants have amended claim 33 to further clarify the subject matter of the present invention and cancelled claims 34, 43 and 53, without prejudice. Support for the amendment to claim 33 may be found, for example, in Fig. 9 of the drawings. No new matter has been added.

For the reasons set forth below, Applicants respectfully submit that all pending claims are patentable over the cited prior art references.

II. The Rejection Of Claims 33, 37-39, 43, 53 And 54 Under 35 U.S.C. § 102

Claims 33, 37-39, 43, 53 and 54 were rejected under 35 U.S.C. § 102(b) as being anticipated by Enomoto (USP No. 5,589,255); and claim 33 was rejected under 35 U.S.C. § 102(b) as being unpatentable over Fujinaka (USP No. 4,806,334). Applicants respectfully submit that Enomoto and Fujinaka fail to anticipate the pending claims for at least the following reasons.

With regard to the present invention, amended claim 33 recites a circuit substrate comprising: a substrate including a first surface and a second surface opposite to the first surface; a first conductor pattern formed on the first surface; a second conductor pattern formed on the second surface; an external terminal formed on the second conductor pattern to mount the circuit substrate on a second substrate; a dielectric layer formed on the second conductor pattern and the second surface; and a third conductor pattern formed on the dielectric layer and the second surface, wherein the second surface has larger surface roughness than the first surface, the dielectric layer covers the edge of the second conductor pattern, the third conductor pattern

covers the edge of the second conductor pattern through the dielectric layer, and the second conductor pattern, the dielectric layer and the third conductor pattern form a capacitor.

One feature of the present invention is that the second surface has a rougher surface than the first surface and a capacitor is formed by the second conductor pattern, a dielectric layer and a third conductor pattern. In addition, the dielectric layer and third conductor pattern cover the top and side edges of the second conductor pattern as shown in Fig. 9. As a result of this feature, the capacitor structure enhances noise reduction which allows for high electrical performance.

In contrast to the present invention, neither Enomoto nor Fujinaka disclose a dielectric layer and third conductor pattern which both cover the edge of the second conductor pattern as recited in claim 33. As such, Enomoto and Fujinaka do not disclose a capacitor like device formed on the second conductor pattern having a function of reducing noise or the function of securing the second conductor pattern on the second surface.

Anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed, either expressly or inherently in a prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), and Enomoto and Fujinaka do not disclose a circuit substrate in which a dielectric layer covers the edge of a second conductor pattern, and a third conductor pattern covers the edge of the second conductor pattern through the dielectric layer, where the second conductor pattern, a dielectric layer and the third conductor pattern form a capacitor. Therefore, as it is apparent from the foregoing that Matsumoto fails to anticipate claim 33, Applicant respectfully requests that the § 102 rejection be traversed.

III. The Rejection Of Claims 33, 34 And 36-42 Under 35 U.S.C. § 103

Claims 33, 34 and 36-42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Horiuchi (USP No. 5,943,212) in view of Enomoto. Applicants respectfully traverse this rejection for at least the following reasons.

As disclosed above, amended claim 33 recites that the second conductor pattern, the dielectric layer and the third conductor pattern form a capacitor and that the dielectric layer and third conductor pattern cover the top and side edges of the second conductor pattern. Horiuchi discloses that the solder resist covers the edge of the second conductor pattern. As can be seen in Fig. 8 of Horiuchi, the solder ball 12 cover the edge of the second conductor pattern 14. However, Horiuchi fails to disclose that the solder resist 12 is an element used to form a capacitor along with the second conductor pattern and the dielectric layer. As shown above, Enomoto fails to disclose this limitation as well. As such, neither Horiuchi nor Enomoto disclose the above cited limitations of amended claim 33.

In order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA1974). As Horiuchi, Enomoto and Fujinaka, at a minimum, fail to describe a circuit substrate wherein the second conductor pattern, the dielectric layer and the third conductor pattern form a capacitor, it is submitted that Horiuchi, Enomoto and Fujinaka do not render claim 33 obvious. Accordingly, it is respectfully requested that the § 103 rejection of claim 33 be withdrawn.

IV. All Dependent Claims Are Allowable Because The Independent Claim From Which They Depend Is Allowable

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 33 is patentable for the reasons set forth above, it is respectfully submitted that all pending dependent claims are also in condition for allowance.


V. Conclusion

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication of which is respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP


Michael E. Fogarty
Registration No. 36,139

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 MEF/NDM:kap
Facsimile: 202.756.8087
Date: November 9, 2007

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